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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/781,579

02/17/2004

Carol Horan

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07/22/2005

Law Office of Kenneth P. Krohn
2131 Palomar Airport Road
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EXAMINER

REESE, DAVID C

ART UNIT

PAPER NUMBER

3677

DATE MAILED: 07/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/781,579

Applicant(s)

HORAN, CAROL

Examiner

David C. Reese

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 2-8, 14, 16, 18, 20 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 9-13, 15, 17, 19, 22 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

[1] Claims 2-8, 14, 16, 18, and 20-21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant's election with traverse of Claims 1-23 in the reply filed on 6/2/2005 is acknowledged. The traversal is on the ground(s) that although the species may be patentably distinct, they are related, and that since all of the species act as an item of jewelry that serves to connect decorative lengths of material, a search for one species will suffice for the others. This is not found persuasive because as applicant stated the species are indeed patentably distinct, and further, applicant is in no position to determine what is or is not a serious burden on the examiner with regard to searching.

The requirement is still deemed proper and is therefore made FINAL.

[2] Claims 1-23 are pending.

Claim Objections

[3] Claim 19 is objected to because of the following informalities: in line 4, the statement, "a first joining member" is not needed since it is stated above adjacent (a). Appropriate correction is required.

Claim Rejections - 35 USC § 103

[4] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

[5] Claims 1, 9-13, 15, 17, 19, 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wright US-5,341,659, in view of Zemer US-2003/0229974.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

As for Claim 1, Wright teaches of an appliance (1, 2) for connecting one or more removable lengths (24, 26) of decorative material worn by a wearer, wherein each of such removable lengths of decorative material has two ends and such ends are adapted to be removably connected to one another, such appliance comprising:

(a) a joining member (1,2), such joining member (1,2) having;

one or more connecting portions (1), each of which is provided a plurality of pivot hooks and rings (17) for detachable connection to one end of each of a plurality of jewelry strands (24,26).

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one or more second connecting portions (2), each of which is provided a plurality of pivot hooks and rings (17) for detachable connection to one end of each of a plurality of jewelry strands (24,26).

The difference between the claim and Wright is the claim recites: wherein each of such first connecting portions (and second connecting portions) has magnetic properties and is adapted to be removably connected by magnetic force to one end of a removable length of decorative material, such end being comprised of a material that may be connected to such first connecting portion by magnetic force, so that such end may be removably connected to the joining member. Zemer discloses a clasp similar to that of Wright. In addition, Zemer further teaches of a joining member (70) possessing one or more first connecting portions, (72) wherein each of such first connecting portions (72) has magnetic properties (80) and is adapted to be removably connected by magnetic force to one end of a removable length of decorative material (84), such end being comprised of a material (88) that may be connected to such first connecting portion (72) by magnetic force (Fig. 5c), so that such end (84) may be removably connected to the joining member (70); and wherein each of such removable lengths of decorative material has two ends (84,74) and such ends are adapted to be removably connected to one another by magnetic force (via 88 and metal). It would have been obvious to one of ordinary skill in the art, having the disclosures of Wright and Zemer before him at the time the invention was made, to modify the pivot hooks and rings for detachable connection to one end of each of a plurality of jewelry strands of Wright to include an alternate means for detachable connection such as by magnetic attraction, as in Zemer. One would have been motivated to make such a combination because first, Wright teaches in col. 3, beginning with line 7, that "Means other than hooks, such

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as rings, can be used as connectors for connecting the ends of the strands to the clasp boxes.” In the art of jewelry, one skilled in the art would recognize that substituting means for connecting two articles for the use of magnets and magnetic attraction is well known and ever more shown by the magnetic clasp as provided by Zemer et al. One would also want to use magnetic attraction as it is aesthetically pleasing, secure, easy to use, and inexpensive to manufacture as stated by Zemer in the summary of the invention.

As for Claim 9, Wright in view of Zemer et al., teach of an appliance (1, 2 of Wright) for connecting one or more removable lengths (24, 26 of Wright) of decorative material worn by a wearer, wherein each of such removable lengths of decorative material has two ends and such ends are adapted to be removably connected to one another, such appliance comprising:

(a) a first joining member (1 of Wright), comprised of:

(i) a first inner surface facing the wearer, a first outer surface approximately opposite the first inner surface, a first lateral fastening surface, and a first lateral exterior surface; and

(ii) two or more first connecting portions (17 of Wright in view of 80,88 of Zemer), wherein each of such first connecting portions has magnetic properties and is adapted to be removably connected by magnetic force to one end of a removable length of decorative material, such end being comprised of a material that maybe connected to such first connecting portion by magnetic force, so that such end may be removably connected to the first joining member;

(b) a second joining member (2 of Wright), comprised of:

(i) a second inner surface facing the wearer, a second outer surface approximately opposite the second inner surface, a first lateral fastening surface, and a second lateral exterior surface; and

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(ii) two or more second connecting portions (17 of Wright in view of 80,88 of Zemer), wherein each of such second connecting portions has magnetic properties and cooperates with one first connecting portion and each such second connecting portion is adapted to be removably connected by magnetic force to the other end of a removable length of decorative material that is removably connected to such cooperating first connecting portion, such other end being comprised of a material that maybe connected to such second connecting portion by magnetic force, so that such end may be removably connected to the second joining member; and

(c) joining member fastening means (18 of Wright) to removably connect the first joining member (1) to the second joining member (2 of Wright);

(d) wherein each of such removable lengths of decorative material has two ends and such ends are adapted to be removably connected by magnetic force to one another (in view of 84 of Zemer).

Re: Claim 10, wherein:

(a) the first joining member (1) is further comprised of:

a first joining portion (19);

a first decorative portion (1);

first joining portion attachment means (17 of Wright in view of 80,88 of Zemer) for attaching the first decorative portion to the first joining portion; and

(b) the second joining member is further comprised of:

a second joining portion (2);

a second decorative portion (22);

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second joining portion attachment means (17 of Wright in view of 80,88 of Zemer) for attaching the second decorative portion to the second joining portion.

Re: Claim 11, wherein,

(a) each first connecting portion (17 of Wright in view of 80,88 of Zemer) is comprised of a first cavity (16) recessed into the first joining member (1), wherein each such first cavity has magnetic properties (in view of Zemer) and is adapted to be approximately of the same size and shape as the end of the removable length of decorative material to which it is removably connected, so that all or a portion of such end may be slideably inserted into and slideably removed from such first cavity (16); and

(b) each second connecting portion (of Wright in view of 80,88 of Zemer) is comprised of a second cavity (16) recessed into the second joining member (2), wherein each such second cavity has magnetic properties and is adapted to be approximately of the same size and shape as the other end of the removable length of decorative material to which it is removably connected so that all or a portion of such other end may be slideably inserted into and slideably removed from such second cavity.

Re: Claim 12, first lateral fastening surface of the first joining member being adapted to be removably connected to the second lateral fastening surface of the second joining member by magnetic force, wherein the first lateral fastening surface and the second lateral fastening surface have magnetic properties (in col. 3 beginning with line 4, "Obviously, other means can be used to connect the clasp boxes," which one skilled in the art will recognize that a magnetic means is applicable for such a means).

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Re: Claim 13, wherein the two more first cavities are located on the first lateral exterior surface of the first joining member and the two or more second cavities are located on the second lateral exterior of the second joining member.

Re: Claim 14, wherein the first joining member and the second joining member are in the shape of a rectangle.

Re: Claim 17, wherein each cavity and its cooperating second cavity are adapted to receive ends and other ends of removable lengths of decorative material wherein such ends and the other ends are approximately circular in shape.

As for Claim 19, Wright in view of Zemer et al., teach of an appliance (1, 2 of Wright) for connecting one or more removable lengths (24, 26 of Wright) of decorative material worn by a wearer, wherein each of such removable lengths of decorative material has two ends such appliance comprising:

(a) a first joining member (1 of Wright), comprised of:

(i) a first inner surface facing the wearer, a first outer surface approximately opposite the first inner surface, a first lateral fastening surface, and a first lateral exterior surface; and

(ii) one or more first connecting portions (17 of Wright in view of 80,88 of Zemer), wherein each of such first connecting portions has magnetic properties and is adapted to be removably connected by magnetic force to one end of a removable length of decorative material, such end being comprised of a material that maybe connected to such first connecting portion by magnetic force, so that such end may be removably connected to the first joining member;

(b) a second joining member (2 of Wright), comprised of:

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(i) a second inner surface facing the wearer, a first outer surface approximately opposite the second inner surface, a second lateral fastening surface, and a second lateral exterior surface; and

(ii) one or more second connecting portions (17 of Wright in view of 80,88 of Zemer), wherein each of such second connecting portions has magnetic properties and cooperates with one first connecting portion and each such second connecting portion is adapted to be removably connected by magnetic force to the other end of a removable length of decorative material that is removably connected to such cooperating first connecting portion, such other end being comprised of a material that maybe connected to such second connecting portion by magnetic force, so that such end may be removably connected to the second joining member; and

(c) magnetic fastening means (in col. 3 beginning with line 4, "Obviously, other means can be used to connect the clasp boxes," which one skilled in the art will recognize that a magnetic means is applicable for such a means) to removably connect the first joining member (1) to the second joining member (2 of Wright);

(d) wherein each of such removable lengths of decorative material has two ends and such ends are adapted to be removably connected by magnetic force to one another (in view of 84 of Zemer).

Re: Claim 22, wherein:

(a) the first joining member (1) is further comprised of:

a first joining portion (19);

a first decorative portion (1);

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first joining portion attachment means (17 of Wright in view of 80,88 of Zemer) for attaching the first decorative portion to the first joining portion; and

(b) the second joining member is further comprised of:

a second joining portion (22);

a second decorative portion (2);

second joining portion attachment means (17 of Wright in view of 80,88 of Zemer) for attaching the second decorative portion to the second joining portion.

Re: Claim 23, wherein,

(a) each first connecting portion (17 of Wright in view of 80,88 of Zemer) is comprised of a first cavity (16) recessed into the first joining member (1), wherein each such first cavity has magnetic properties (in view of Zemer) and is adapted to be removably connected by magnetic force to one end of a removable length of decorative material (24,26), such end being comprised of a material that may be connected to such first cavity portion by magnetic force (in view of Zemer), and wherein each such first cavity portion (16) is adapted to be approximately of the same size and shape as the end of the removable length of decorative material (24,26) to which it is removably connected, so that all or a portion of such end may be slideably inserted into and slideably removed from such first cavity (16); and

(b) each second connecting portion (of Wright in view of 80,88 of Zemer) is comprised of a second cavity (16) recessed into the second joining member (2), wherein each such second cavity (16) has magnetic properties (in view of Zemer) and cooperates with one first cavity portion (16) and each such second cavity portion is adapted to be approximately of the same size and shape as the other end of the removable length of decorative material to which it is

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removably connected so that all or a portion of such other end may be slideably inserted into and slideably removed from such second cavity (16).

Conclusion

[6] The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited further to show the state of the art with respect to this particular type of clasp system; as well as their extreme relevance to the current application as many read extensively onto the claimed invention: please see submitted notice of reference cited.


[7] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272-7082. The examiner can normally be reached on 7:30 am-6:00 pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached on (571) 272-7075. **Until July 14th, the fax phone number for the organization where this application or proceeding is assigned is 703-872-9306; starting July 15th, however, the new fax phone number will be (571) 273-8300, please make note.**

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sincerely,
David Reese
Assistant Examiner
Art Unit 3677

DCR


ROBERT J. SANDY
PRIMARY EXAMINER